

## PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE FAX RECEIVED*In re* Application of:William J. WELSH *et al.*

Serial No.: 10/665,377

Filed: September 18, 2003

For: OPIATE ANALOGS SELECTIVE FOR  
THE  $\delta$ -OPIOID RECEPTOR

Group Art Unit: 1625

Examiner: D.M. Seaman

Atty. Dkt. No.: UVMO:021US

AUG 17 2006

OFFICE OF PETITIONS

CERTIFICATE OF FACSIMILE TRANSMISSION  
37 C.F.R. § 1.8

I hereby certify that this correspondence is being faxed to:  
Mail Stop Petition; Commissioner for Patents, P.O. Box  
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273-0025 on the date below:

August 17, 2006  
Date

Steven L. Highlander

PETITION UNDER 37 C.F.R. § 1.313(c)(2)

**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This is a petition to withdraw U.S. Serial No. 10/665,377 from issue under 37 C.F.R. § 1.313(c)(2) in consideration of a request for continued examination in compliance with 37 C.F.R. § 1.114. This petition is necessitated because a supplemental European Search Report for the EP counterpart of this case identified Gao, Peng et al., *J. Med. Chem.* 1998, 41, 3091-3098 as an allegedly anticipatory reference. This reference is contained in the IDS which is attached to this petition.

08/21/2006 CKHLDK 00000001 501212 10665377

01 FC:1464 130.00 DA

Attached as Appendixes A-E are:

Appendix A: Supplemental Information Disclosure Statement

Appendix B: PTO Form 1449

Appendix C: Supplementary European Search Report

Appendix D: Gao, Peng et al., *J. Med. Chem.* 1998, 41, 3091-3098

Appendix E: Request for Continued Examination

The fee for the petition as set forth in § 1.17(h) is \$130. The Commissioner is hereby authorized to charge this fee and any fees which are believed to be due in connection with this filing under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski Deposit Account No.: 50-1212/UVMO:021US/SLH.

Should the examiner have any questions regarding this petition, a telephone call to the undersigned is invited.

Respectfully submitted,

  
Steven L. Highlander  
Reg. No. 37,642  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

Date: August 17, 2006

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**FULBRIGHT & JAWORSKI L.L.P.**  
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OFFICE OF PETITIONS

## FACSIMILE TRANSMISSION

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*Randy*  
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<b>TRANSMITTAL FORM</b>	<b>Application Number:</b>	10/665,377
	<b>Filing Date:</b>	September 18, 2003
	<b>First Named Inventor:</b>	William J. Welsh
	<b>Art Unit:</b>	1625
	<b>Examiner Name:</b>	D.M. Seaman
Total Number of Pages in this Submission : <u>23</u>	<b>Attorney Docket Number:</b>	UVMO:021US
		<b>OFFICE OF PETITIONS</b>

**ENCLOSURES (check all that apply)**

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input checked="" type="checkbox"/> Supplemental Information Disclosure Statement <input checked="" type="checkbox"/> Form PTO-1449 <input checked="" type="checkbox"/> References C43 <input type="checkbox"/> Foreign Search Report  <input type="checkbox"/> Certified Copy of Priority Documents  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts/Requirements <input type="checkbox"/> Declaration(s) _____ <input type="checkbox"/> Copy of Notice of Missing Parts/Requirements	<input type="checkbox"/> Drawings(s) _____  <input type="checkbox"/> Licensing-related Papers  <input checked="" type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Statement under 37 CFR §3.73(b) <input type="checkbox"/> Designation of Patent Practitioners  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below)
		<input type="checkbox"/> Check in the amount of \$ _____
		<input checked="" type="checkbox"/> Authorized to be charged to deposit account if check insufficient or inadvertently omitted Deposit account number: 50-1212/UVMO:021US/MHV
		<input type="checkbox"/> Sequence Statement
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		<input type="checkbox"/> Postcard
		<input checked="" type="checkbox"/> Supplementary European Search Report
		<input checked="" type="checkbox"/> Request for Continued Exam

**Remarks:**

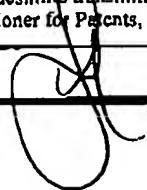
Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/UVMO:021US/MHV

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Fulbright & Jaworski L.L.P.	Customer Number	32425
Signature			
Printed Name	Steven L. Highlander	Reg. No.	37,642
Date	August 17, 2006		

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

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## APPENDIX A